

DOCKET NO: 255563US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
VINCENT GOFFIN, ET AL. : EXAMINER: WILSON, MICHAEL C.
SERIAL NO: 10/500,968 :
FILED: MAY 4, 2005 : GROUP ART UNIT: 1632
FOR: MAMMAL PROLACTIN :
VARIANTS

RESTRICTION RESPONSE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction requirement dated June 11, 2007, Applicants elect, with traverse, Group I, Claims 1-5, for examination.

REMARKS/ARGUMENTS

The claims have been divided into Groups as follows:

- Group I: Claim(s) 1-5, drawn to a prolactin variant.
- Group II: Claim(s) 6-9, drawn to a nucleic acid encoding the prolactin variant and a host cell comprising the nucleic acid.
- Group III: Claim 10, drawn to a transgenic animal comprising the nucleic acid sequence encoding the prolactin variant.
- Group IV: Claim 11, drawn to a therapeutic composition comprising the nucleic acid sequence encoding the prolactin variant.
- Group V: Claim 12, drawn to a method of treating disease involving PRL-mediated effects using the prolactin variant.

Applicants elect, with traverse, Group I, Claims 1-5, for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Examiner has asserted that Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding technical features. The Examiner has cited Adreis (Biochem. J., 1992, Vol. 281, pp 393-400) and Goffin (J. Bio. Chem., July 12,1996, Vol. 271, 28, pp. 16573-16579) in support of this assertion.

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided sufficient indication that the contents of the claims interpreted in light of the description was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

Moreover, Applicants respectfully refer to Annex B of the Administrative Instructions Under the PCT, paragraph (c), which states in part, “Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and

not the dependent claims.” Applicants note that Claims 2-12 all depend directly or indirectly from Claim 1 in this application.

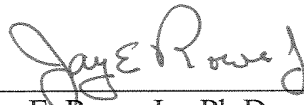
Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of lack of unity of invention.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants submit that the above-identified application is now in condition for examination on the merits and early notice of such action is earnestly solicited.

Respectfully submitted,

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